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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/316,313 05/21/99 PRATAP

R U-012254-3

EXAMINER

HM12/0530

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HUANG, E

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

05/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/316,313

Applicant(s)

Pratap

Examiner

Evelyn Huang

Group Art Unit

1625



☒ Responsive to communication(s) filed on May 11, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 11-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 11-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 11-20 are pending. Claims 1-10 have been canceled according to the amendment filed on 5-8-2000.

***Claim Rejections - 35 USC § 112***

2. The 112 second paragraph rejection for claims 1-10 is rendered moot by the cancellation of these claims. However, new claims 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term 'derivative' has no antecedent basis in the base claim 11.

***Claim Rejections - 35 USC § 103***

3. The 102(b) rejection over Andersag is withdrawn but the 103 rejection over Andersag is maintained because it is applicable for claims 11-20 for reasons set forth in the previous office action.

Andersag generically teaches the instant compound, its method of use and the process of making the compound (page 1, columns 1-2). Specific compounds and their process of <sup>making</sup> ~~make~~ are described in Examples 10, 11 (page 2, column 2).

Applicant argues that the instant has an amino- methyl-butyl-amino whereas the compound of Example 11 (page 2, lines 45-48) has an amino n-pentyl-amino and an additional methyl on the butyrolactone. However, amino- methyl-butyl-amino and amino n-pentyl-amino are optional choices within amino-alkyl-amino while methyl on the butyrolactone is also optional (page 1, lines 44-45; 49-52). An example of the butyrolactone without methyl substitution is shown in Example 10 (page 2, lines 8-9). At the time of the invention, one of ordinary skill in the art would be motivated to modify the compound of Example 11 by replacing with the alternative substituents to arrive at the instant invention since Andersag had clearly taught that any

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species within the disclosed genus would be effective in treating malaria. In the absence of unexpected results, the instant method of using the compound and the process for making the compound remain obvious over Andersag.

Applicant argues that Andersag only generically teaches the use of the compound to treat malaria, among other uses. However, Andersag teaches that this class of compounds is particularly useful for combating malaria parasites (page 1, column 1, lines 7-8). Guided by the teaching of Andersag, one of ordinary skill in the art would be motivated to use any of the species within the disclosed genus to treat malaria. While applicant recites the various advantages of the instant compounds over primaquine, advantages over the prior compound is not described and the instant therefore remains obvious over the prior art of record.


### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is (703) 305-7247.

  
EVELYN MEI HUANG  
PRIMARY EXAMINER

May 23, 2000